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EXAMINER

MACKEY, PATRICK HEWEY

| | |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3651

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,589

Applicant(s)

BENNETT ET AL.

Examiner

Patrick H. Mackey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-29 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-29 and 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 25 August 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The amendment filed 8/25/2003 has been entered.

Drawings

2. The proposed drawings submitted 8/25/2003 have not been approved by the examiner because they contain new matter. Figure 5B is new matter because it illustrates a relationship between elements 530 and 535 in a manner not disclosed in the specification as filed.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the elongate slit nozzle, the nozzle coupled to the deflector, the central nozzle larger than the side nozzle, and the central nozzle directing a greater gas volume must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 28, 29, 31, and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

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claimed invention. Claim 28 states “the central and side nozzles are fixedly coupled together using a fixture in a non-parallel arrangement”, claim 31 states “wherein the first and second directions are non-parallel and wherein the central nozzle is larger than the side nozzle” and claim 35 states “wherein the central nozzle directs a greater gas volume into the envelope than the side nozzle.” There is no support in the disclosure as filed for these limitations.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 28, 29, 31, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Maltman et al. Maltman discloses a mail processing apparatus that includes a track (90), an envelope feeder ⁹⁰, an inserting mechanism (70), a central nozzle (25b), a side nozzle (25a), an adjust nozzle (50), and a fixture (30).

8. Claims 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by McCain et al. McCain discloses an apparatus that processes mailers (magazines) that includes a track (75), a moving mechanism with a pair of fingers (76-1, 76-2), a grasping mechanism (20-1, 20-2), an elongate slit nozzle (89) coupled to the grasping mechanism (20-1, 20-2), a bin (10), and a vacuum finger (26).

9. Claims 11, 24, 32, 33, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Muller. Muller discloses a method for processing mailers (magazines) that includes passing first and second sheets (P) along a track (14), adding an insert to the first sheet (see col. 4, line 15) by

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grasping the insert with a grasping mechanism (12a with grippers), deflecting the insert onto the first sheet (see col. 4, line 15) utilizing deflectors (13a-13c), and holding the insert to the first sheet by directing a gas stream onto the insert (see Fig. 3 and col. 5, lines 19-46) utilizing a nozzle (20) coupled to the deflector.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCain et al. in view of Manley. McCain et al. discloses all the limitations of the claims, but it does not disclose a pressure sensor or optical sensor adapted to detect if an insert has been grasped or if more than one insert has been grasped by the grasping mechanism with an indicator and an interrupt circuit. However, Manley discloses an apparatus for handling mailers (newspapers) that includes a pressure sensor (146) or optical sensor (incorporating US 4,753,430 item 80 by reference at col. 13, line 33) adapted to detect if an insert has been grasped or if more than one insert has been grasped (incorporating US 4,527,793 item 5 by reference at col. 13, line 33) by the grasping mechanism with an indicator (see col. 12, line 30, "signal") and an interrupt circuit (see col. 12, line 9) for the purpose of preventing improperly formed mailers from being formed while maintaining the mailers in a delivery sequence (see col. 2, lines 1-30). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify McCain by utilizing a pressure sensor or optical sensor adapted to detect if an insert has been

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grasped or if more than one insert has been grasped by the grasping mechanism with an indicator and an interrupt circuit, as disclosed by Manley, for the purpose of preventing improperly formed mailers from being formed while maintaining the mailers in a delivery sequence.

12. Claims 1-4, 6, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newsome in view of Otter et al. Newsome discloses an apparatus for processing mailers (magazines) that includes a paper feeding mechanism (30), a collection bin (33), a retrieval mechanism (38), and a printer (see col. 3, line 23). Newsome discloses all the limitations of the claims, but it does not disclose a deionizer. However, Otter discloses a collection bin that includes a deionizing static bar (172) for the purpose of preventing curl in sheets (see col. 1, lines 10-20). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Newsome by including a deionizer, as disclosed by Otter, for the purpose of preventing curl in sheets.

13. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newsome in view of Otter as applied to claim 1 above, and further in view of Tress et al. Newsome and Otter, together, disclose all the limitations of the claims, but neither reference discloses a foot. However, Tress discloses an insert device that includes a foot (42) for the purpose of ensuring only one sheet is separated from the bottom of a stack. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to utilize a foot, as disclosed by Tress, for the purpose of ensuring only one sheet is separated from the bottom of a stack.

14. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newsome in view of Otter as applied to claim 1 above, and further in view of Hill et al. Newsome and Otter, together, disclose all the limitations of the claims, but neither reference discloses a card

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attachment mechanism and a folder. However, Hill discloses an insert device that includes a card attachment mechanism (26a) and a folder (86) for the purpose of preparing insert packages that include cards. It would have been obvious for a person of ordinary skill in the art, at the time of the applicant's invention to utilize a card attachment mechanism and a folder for the purpose of preparing insert packages that include cards.

15. Claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller in view of Manley. Muller discloses all the limitations of the claims (see above), but it doesn't disclose sensing whether the grasping mechanism has grasped only one insert or has grasped more than one insert and ceasing the passing and adding. However, Manley discloses sensing whether the grasping mechanism has grasped only one insert or has grasped more than one insert and ceasing the passing and adding for the purpose of preventing improperly formed mailers from being formed while maintaining the mailers in a delivery sequence. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Muller, by sensing whether the grasping mechanism has grasped only one insert or has grasped more than one insert and ceasing the passing and adding, as disclosed by Manley, for the purpose of preventing improperly formed mailers from being formed while maintaining the mailers in a delivery sequence.

Response to Arguments

16. Applicant's arguments filed 8/25/2003 have been fully considered but they are not persuasive.

17. The applicant states that Newsome is silent as to how the signatures are deposited into the hoppers. In response, see Newsome, col. 9.

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18. The applicant states that the claimed deionizer serves a different function in claim 1 than the anti-static bar of Otter. In response to applicant's argument, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

19. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Otter discloses a collection bin that includes a deionizing static bar (172) for the purpose of preventing curl in sheets (see col. 1, lines 10-20). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Newsome by including a deionizer, as disclosed by Otter, for the purpose of preventing curl in sheets.

20. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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21. The applicant states that Newsome fails to disclose feeding sheets sequentially into a collection bin to form a stack. In response, see Newsome, Figure 3. The applicant states that Otter fails to disclose removing a bottom sheet from a stack after the sheets have been sequentially passed over the deionizer. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
22. The applicant states that McCain does not disclose a grasping mechanism that travels in a first direction prior to grasping the insert and in a second direction to move the insert. The examiner disagrees with the applicant's assertions. McCain discloses that a grasping mechanism travels upward prior to grasping the insert and downward to move the insert (see at least Fig. 8).
23. The applicant states that Muller does not disclose grasping an insert, moving the insert onto a sheet to form a stack, releasing the insert from the grasping mechanism and holding the insert to a sheet. The applicant states that the sheet does not rest on a stack until after a pusher has removed it from a platform. In response, the examiner notes that Muller discloses that a sheet extends beyond the platform (see col. 4, lines 50-60) prior to being engaged by the pushers and is supported by a stack of sheets (see Fig. 3).
24. The applicant states that Muller does not facilitate the passage of transfer unit over the stacked sheets. In response, the examiner notes that the applicant has not defined the term "facilitate" in any manner such that it does not read on Muller.

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25. The applicant states that Maltman does not disclose nozzles in a non-parallel arrangement. In response, see Maltman col. 7, lines 55-69.

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick H. Mackey whose telephone number is (703) 308-0630. The examiner can normally be reached on Tuesday-Friday 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (703) 308-2560. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to be 'PM' or similar initials, written in a cursive style.

Patrick H. Mackey
Primary Examiner
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October 6, 2003